

**Remarks**

Claims 2, 4, and 6-20 are pending in the application. Claims 1, 3, and 5 have been cancelled and rewritten as new claim 20. Applicants thank the Examiner for indicating the allowability of claims 8 and 13-14.

**Claim Objection under 37 C.F.R. § 1.75(c)**

The Office Action rejected claims 17-19 for failure to limit the subject matter of a previous claim. This rejection is respectfully traversed. The test for a proper dependent claim is whether it includes all of the limitations of the claim from which it depends, and not whether a further limitation changes the scope of the claim. See MPEP, 8<sup>th</sup> Ed, Rev. 4, 608.01(n) III Withdrawal of the objection is respectfully requested.

**Claim Rejection under 35 U.S.C. § 101**

Method claims 17-19 stand rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. The action suggests that method claims depending from an apparatus claim are somehow non-statutory because they "are directed to more than one statutory invention(s)." However, the MPEP, 8<sup>th</sup> Ed, Rev. 4, at § 2173.05(p) recognizes that there are a number of instances where a claim may include reference to more than one statutory class of invention. Accordingly, this by itself, does not make a claim non-statutory.

Moreover, the Board of Patent Appeals and Interferences expressly held that a "utilizing" of this type was not indefinite under § 112. See *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992), and MPEP, 8<sup>th</sup> Ed, Rev. 4, § 2173.05(q), which expressly refers to *Ex*

*parte Porter* Accordingly, claims 17-19 are submitted to be proper dependent claims.

Withdrawal of this rejection is respectfully requested.

Claim Rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph

Claims 1-19 were rejected as being indefinite. Claim 5 has been cancelled and rewritten as new claim 20, which incorporates the subject matter of claim 1 as well as claim 3 to provide proper antecedent support for the "deposit tray magazine." In addition, the "thickness" in claim 20 has been redefined as the "vertical height" of the printed products, since the Examiner's suggestion of "in the direction on [sic, should be "of"] conveyance" could be ambiguous in that there is both vertical and horizontal conveyance of the printed product in the conveying section of the exemplary embodiments disclosed in the application. As claim 5 originally depended from claim 1 through claim 3, it is submitted that claim 20 raises no new issues and does not require further search. Minor conforming amendments have additionally been made to 2, 4, 6, 7, 10, 15, and 17-19.

Rejection under 35 U.S.C. § 102

Claims 3-7 and 9-12 were rejected as anticipated by Ruder (DE 38 29 355 A1). As new claim 20 includes the limitations of claims 1, 3, and 5, it is believed that this rejection is now moot. Withdrawal is respectfully requested.

Rejection under 35 U.S.C. § 103: U.S. Patent 5,473,978 to Columbo ("Columbo")

The Office Action rejected claims 2, 5-6 and 15-16 over Columbo. As discussed above, new claim 20 includes the limitations of claim 1. Therefore, it is believed that the rejection is now moot. Withdrawal is respectfully requested.

Rejection under 35 U.S.C. § 103: Ruder in view of Holtman (EP 0888 994 A1 )

The Office Action rejected claims 1-7 and 9-12 as obvious over Ruder in view of Holtman. . This rejection will be treated as if applying to claim 20 and the claims dependent thereon, since as noted above claim 20 comprises the subject matter of claim 1, 3 and 5.

Applicants traverse the rejection

Ruder is directed to an arrangement for storage of flat products designed for storage and removal of defective stacks as part of a book block production line. Ruder does not disclose a deposit tray magazine which "is arranged for making the deposit trays available for accommodating a printed product at the intake area [of the conveying section]," as required by claim 20. Rather, what the Examiner's Action identifies as a deposit tray magazine appears to be the storage units 4 and 6 in which trays are transported. This could be construed as relating to the conveying section and the plurality of trays as recited in the first two paragraphs of claim 20, but not the separately claimed deposit tray magazine that supplies trays to the conveying section as described and claimed in the present application. Additionally, the storage components 16 of Ruder are not adjustable and cannot accommodate stacks of varying heights. Thus, Ruder does not disclose Applicants' required

claim limitation of "a control mechanism for controlling a distance between respectively adjacent deposit trays . . . based on a height of the printed products."

The Holtman reference is directed to a printing apparatus for depositing stacks of sheets on adjustable supports. Like Ruder, Holtman does not disclose a deposit tray magazine. As Holtman does not remedy the deficiencies of Ruder, the combination of references cannot render the present claims obvious.

The Office Action asserts that "it would have been obvious to modify Ruder to provide control as a function of product thickness in order to increase efficiency as taught by Holtman." (See Office Action, page 4, paragraph 10.) Applicants disagree.

First, there is no motivation to combine the references. As discussed above, Ruder is an apparatus for storage and removal of faulty stacks in a book production line, where Holtman is for depositing printed sheets on adjustable supports. The cited references each perform different functions in order to address different needs in the art. It is respectfully submitted that a person skilled in the art would have no incentive to modify the apparatus of Ruder to accommodate stacks of varying thickness, as the invention of Ruder lacks both the design, the intent, and the need to do so. There is nothing in the disclosure of Ruder to suggest that the stacks are of varying thickness, or that stacks of varying thickness are an issue in Ruder that must be dealt with. Such a suggestion comes solely from the Examiner's Action, which has the benefit of Applicants' disclosure to use in an impermissible hindsight reconstruction of Applicants' invention.

Moreover, even if one of skill in the art were to combine the Ruder and Holtman references as suggested by the Examiner's Action, the claimed invention still would not result.

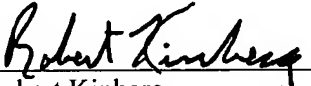
The combination suggested by the Examiner's Action would still lack a deposit tray magazine "arranged for making the deposit trays available for accommodating a printed product at the intake area [of the conveying section]" as discussed above. Applicants' invention is a conveying arrangement for processing printed products that allows storage of printed products of varying height, for example, while the printed products cool and/or dry. To accommodate the products of different height, it is necessary to vary the spacing between the deposit trays in the conveying section. The invention utilizes a deposit tray magazine in a novel combination with a conveying section to control the spacing between the trays supplied to the conveying section in a manner that is not taught by any reasonable combination of Ruder and Holtman. The cited references do not have such a capability and do not, either singly or in combination, disclose all the limitations of independent claim 20. Therefore, claim 20, and dependent claims 2, 4, and 6-19 are submitted to be allowable. Withdrawal of the rejection is respectfully requested.

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicants request that the Examiner issue a Notice of Allowance indicating the allowability of claims 2, 4, and 6-20 and that the application be passed to issue.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Respectfully submitted,

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